

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86277101
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/86277101/large
LITERAL ELEMENT	GOLD DEF
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p>The Examining Attorney has issued a final refusal to register Applicant's mark GOLD DEF on the ground that it is likely to be confused with the registered marks GOLD DIESEL, Reg. No. 2496659, and GOLD DIESEL PLUS, Reg. No. 2785873. Applicant respectfully submits this request for reconsideration, as the final refusal fails to properly apply the anti-dissection rule. Had that long-standing doctrine been properly considered, Applicant maintains that these marks would not be deemed confusingly similar.</p> <p>The anti-dissection rule states that a composite mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts. According to the United States Supreme Court: "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." <u>Estate of P. D. Beckwith, Inc. v. Commissioner of Patents</u>, 252 U.S. 538, 545-6 (1920). <u>See also California Cooler, Inc. V. Loretto Winery, Ltd.</u>, 774 F.2d 1451, 1455, 227 U.S.P.Q. 808, 810 (9th Cir. 1985) (the mark CALIFORNIA</p>	

COOLER "is a composite term and its validity is not judged by an examination of its parts. Rather, the validity of a trademark is to be determined by viewing the trademark as a whole.").

In its response to the first office action, Applicant established that the facts of this matter closely parallel those of several cases in which composite marks with shared terms have been allowed to coexist on the Principal Register. Those cases involved comparisons of multi-word trademarks that share a weak or highly diluted term plus a highly descriptive or generic term, and identified same or related goods and services. Thus, LITTLE CAESAR and PIZZA CAESAR, both of which identify pizza restaurants, coexist on the PTO register (Little Caesar Enterprises Inc. v Pizza Caesar Inc., 834 F.2d 568 (6th Cir. 1987)); BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL, both of which identify lodging reservation services, coexist on the PTO register (In re B&B Registry, 791 F.2d 157 (Fed. Cir. 1986)); and NEW CHOICES FOR THE BEST YEARS and NEW CHOICE PRESS, which identify magazines and publishing services respectively, coexist on the PTO register (Lang v. Retirement Living Publishing Co., Inc., 21 U.S.P.Q.2d 1041 (2nd Cir. 1991)).

Applicant further established in its response to the first office action that the term GOLD in both parties' marks is highly diluted in the field of goods related to those the parties' marks identify. The Examining Attorney did not refute this finding. Nor did the Examining Attorney argue that the terms DIESEL and DEF are identical in meaning. While they may identify related or complementary products, they create distinct commercial impressions on consumers, have distinct pronunciations, and meanings.

It follows that no prospective consumer would mistakenly assume that by virtue of the word GOLD that the goods offered under the parties' marks share a common source. See In Re Bed & Breakfast Registry, 229 U.S.P.Q. 818, 819 (Fed. Cir. 1986) (when analyzing the likelihood of confusion between two marks that share similar words, a large number of third party uses of the shared words weighs against the reasonableness of the assumption that the two services come from the same source).

In the final refusal, the Examining Attorney emphasized her view that the term GOLD is

dominant in Applicant's mark and gave only glancing notice to the anti-dissection rule. Indeed, the only mention of this important and, to this case, critical, rule is the following sentence:

Marks must be compared in their entirety and should not be dissected; however, a trademark examining attorney may weigh the individual components of a mark to determine its overall commercial impression [citations omitted].

The Examining Attorney did not discuss any of the anti-dissection case law presented in Applicant's response to the first office action and did not address Applicant's evidence of strong parallels between the facts of this case and those of several federal appellate decisions permitting registration of marks that shared so-called dominant terms, when those terms were highly diluted and accompanied by highly descriptive or generic terms.

Accordingly, Applicant requests that these issues be fully considered now, that the final refusal be withdrawn, and that its application be approved for publication at an early date.

SIGNATURE SECTION

RESPONSE SIGNATURE	/Andrew B. Katz/
SIGNATORY'S NAME	Andrew B. Katz
SIGNATORY'S POSITION	Attorney of Record, Member PA Bar
SIGNATORY'S PHONE NUMBER	215 658 1890
DATE SIGNED	09/09/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

FILING INFORMATION SECTION

SUBMIT DATE	Wed Sep 09 13:00:50 EDT 2015
TEAS STAMP	USPTO/RFR-173.15.168.10-2 0150909130050454969-86277 101-540c3a8f3b91bbe6e8fcc 6b6d8a67e1d03e371082607f9 fe9865c711a938139c-N/A-N/ A-20150909125530244711

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **86277101** GOLD DEF(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/86277101/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

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Had that long-standing doctrine been properly considered, Applicant maintains that these marks would not be deemed confusingly similar.

The anti-dissection rule states that a composite mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts. According to the United States Supreme Court: "The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." Estate of P. D. Beckwith, Inc. v. Commissioner of Patents, 252 U.S. 538, 545-6 (1920). See also California Cooler, Inc. V. Loretto Winery, Ltd., 774 F.2d 1451, 1455, 227 U.S.P.Q. 808, 810 (9th Cir. 1985) (the mark CALIFORNIA COOLER "is a composite term and its validity is not judged by an examination of its parts. Rather, the validity of a trademark is to be determined by viewing the trademark as a whole.").

In its response to the first office action, Applicant established that the facts of this matter closely parallel those of several cases in which composite marks with shared terms have been allowed to coexist on the Principal Register. Those cases involved comparisons of multi-word

trademarks that share a weak or highly diluted term plus a highly descriptive or generic term, and identified same or related goods and services. Thus, LITTLE CAESAR and PIZZA CAESAR, both of which identify pizza restaurants, coexist on the PTO register (Little Caesar Enterprises Inc. v Pizza Caesar Inc., 834 F.2d 568 (6th Cir. 1987)); BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL, both of which identify lodging reservation services, coexist on the PTO register (In re B&B Registry, 791 F.2d 157 (Fed. Cir. 1986)); and NEW CHOICES FOR THE BEST YEARS and NEW CHOICE PRESS, which identify magazines and publishing services respectively, coexist on the PTO register (Lang v. Retirement Living Publishing Co., Inc., 21 U.S.P.Q.2d 1041 (2nd Cir. 1991)).

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SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Andrew B. Katz/ Date: 09/09/2015

Signatory's Name: Andrew B. Katz

Signatory's Position: Attorney of Record, Member PA Bar

Signatory's Phone Number: 215 658 1890

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86277101

Internet Transmission Date: Wed Sep 09 13:00:50 EDT 2015

TEAS Stamp: USPTO/RFR-173.15.168.10-2015090913005045

4969-86277101-540c3a8f3b91bbe6e8fcc6b6d8

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